

REMARKS

Applicants appreciated the opportunity to conduct an interview with the Examiner and her supervisor on December 20, 2004, and would like to thank the Examiner for the courtesies extended. In view of these discussions of the present invention, new independent Claims 48 and 49 have been added, and Applicant requests entry of these new claims. The Examiner is respectfully requested to reconsider and withdraw the rejections in view of the amendments and remarks contained herein.

Claims 2-11, 14, 16-19, 21-45, and 47-49 are now pending in the application. New independent claims 48 and 49 are directed to similar subject matter as that of cancelled independent Claims 20 and 46, respectively. Dependent Claim 15 has also been cancelled. Claims 2-11, 14, 16-19, 21-45, and 47-49 stand rejected under §103(a).

New independent claims 48 and 49 have been included to more particularly point out and distinctly claim the invention, and should not be construed as narrowing amendments as to the scope of the claims. Support for these new claims is found in Applicants' specification at: page 9 line 35 bridging page 10 line 3; page 10 lines 12-16; page 10 lines 23-24; page 11 line 27 bridging page 12 line 3, for example. Further, additional amendments to the claims modify the dependency of the claims or provide proper antecedent basis. The scope of amended Claims 7, 14, 15, 21, 24-28, and 47 are commensurate with their scope as originally filed, and the amendments should not be construed as limiting the scope of these claims, and a full range of equivalents should be allowed.

The following remarks are believed to be fully responsive to the outstanding Office Action and to render all claims at issue patentably distinct over the references

cited. The Examiner is respectfully requested to reconsider and withdraw the rejections in view of the amendments and remarks contained herein.

REJECTION UNDER 35 U.S.C. § 112

Claims 2-11, 14-19, 20-45, and 46-47 stand rejected under 35 U.S.C. § 112, first paragraph, for not enabling the invention as claimed. Independent Claims 20 and 46 have been cancelled, and independent Claims 48 and 49 have been added. Claim 15 has also been cancelled. This rejection is respectfully traversed. For purposes of clarification, Applicants have included description in Claims 48 and 49 relating to a reaction region disposed between an inlet and an outlet of a shift reactor, where the reaction region includes a water gas shift catalyst that is disposed within the reaction region and extends to the outlet. The reaction region also includes a carbon monoxide adsorbent disposed between the inlet and the outlet. Applicants submit that Claims 48 and 49 are in condition for allowance, and request that the rejection under §112 be withdrawn.

REJECTION UNDER 35 U.S.C. § 103

At the outset, Applicants would like to specifically address the primary references relied upon for the rejections under 35 U.S.C. §103(a) in light of the newly added independent Claims 48 and 49, prior to addressing the specific rejections.

BELLOWS ET AL. (USPN 5,604,047)

Bellows does not specifically disclose, nor does it teach or suggest the limitations

of newly added Claims 48 and 49, particularly, a shift reactor having a reaction region including a water gas shift catalyst and a carbon monoxide adsorbent. Bellows merely intimates in passing that a shift reaction can be used to generate a gas stream by any number of "well-known processes" including steam reformation of methanol followed by "the equally well known carbon monoxide shift reaction". See Bellows col. 2 lines 28-36. Bellows does not disclose providing a water gas shift reactor, nor does it suggest including a water gas shift reactor that has an adsorbent active to adsorb carbon monoxide at substantially ambient temperature and pressure conditions and to desorb carbon monoxide at normal shift reactor operating temperature and pressure conditions which are above ambient temperature and pressure conditions. As it is common to combine a shift reactor and reformer, there is no suggestion to one of skill in the art that the shift reaction in Bellows would even provide a separate water gas shift reactor at all (see for example, Hufton et al. "Sorption Enhanced Reaction Process for Hydrogen Production", AIChE at pg. 250 col. 1 lines 9-10).

Additionally, Claims 48 and 49 relate to a shift reactor including a reaction region having an inlet and an outlet, where a water gas shift catalyst is disposed within the reaction region and extends to the outlet, and where a carbon monoxide adsorbent is also disposed within the reaction region between the inlet and the outlet. The carbon monoxide adsorbent is active to adsorb carbon monoxide at substantially ambient temperature and pressure conditions, and to desorb carbon monoxide at normal operating conditions for the shift reactor, which are above the ambient temperature and pressure conditions. Bellows has no disclosure, teaching, or suggestion whatsoever regarding an adsorbent that is capable of adsorbing carbon monoxide at ambient

conditions, generally corresponding to start-up conditions, and desorbing at operating conditions of the shift reactor.

“Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching suggestion or incentive supporting the combination.” *In re Geiger*, 2 USPQ.2d 1276, 1278 (Fed. Cir. 1987). In Bellows, there is no suggestion or motivation to include a water gas shift reactor, nonetheless to combine it with an adsorbent. Further, there is no teaching or disclosure of the desirability of having a carbon monoxide adsorbent that adsorbs at ambient conditions and desorbs at operating conditions of the shift reactor, addressing system issues associated with start-up of fuel cells. Bellows fails to recognize any issues associated with start-up and as such fails to suggest any combinations or improvements in the system that would pertain to improving start-up by improving the system efficacy, efficiency, and/or by minimizing start-up times.

Further, it would not be obvious to combine an adsorbent disclosed in Bellows with an upstream reactor, because the adsorbent only has a capacity to clean carbon monoxide from a stream having a concentration of 0.5% CO. Thus, the adsorbent disclosed in the downstream separator of Bellows would not lead one of skill in the art to use it interchangeably anywhere in the system because of its relatively low carbon monoxide removal capacity. This is particularly true where placing it into a reaction region of an upstream shift reactor would expose the adsorbent to carbon monoxide at a concentration at least two orders of magnitude greater. For example, see Fig. 1 of Hufton, below, where the stream entering a water gas shift reactor is at about 9 % by weight.

MEYER (USPN 3,011,589)

Meyer relates to separating various constituents from a refinery waste gas (see Col. 1 line 59, for example), by a multi-step process, with no disclosure of a fuel cell system whatsoever. One aspect of this separation process includes the non-specific adsorption of methane, nitrogen, and carbon monoxide impurities from the waste gas stream at temperatures of less than -285°F and pressures greater than 2000 p.s.i., preferably greater than 2500 p.s.i.g. (see col. 3 lines 25-32, for example). In fact, Meyer discloses the criticality of having the temperature less than -285°F to adsorb nitrogen and "other impurities" including carbon monoxide, *inter alia*. Col. 3 lines 49 – 57. Meyer also discloses that of "at least equal criticality is the pressure in excess of 2000 p.s.i.g.". Col. 3 lines 62-65. Adsorbents that operate effectively at such extreme temperature and pressure conditions are highly energy intensive and inefficient and would not be suitable in a modern fuel cell application. In stark contrast to Meyer, Claims 48 and 49 both have a selective carbon monoxide adsorbent that is active to adsorb carbon monoxide at substantially ambient temperature and pressure conditions and to desorb carbon monoxide at normal shift reactor operating temperature and pressure conditions which are above the ambient temperature and pressure conditions.

SMITH ET AL. (USPN 3,699,218)

Like the Meyer reference, the Smith reference discloses an adsorbent that must operate at conditions that are impracticable and entirely unsuitable in a modern fuel cell application. Smith discloses a carbon monoxide adsorbent that operates at a temperature of less than 0°F, more preferably as close as possible to the boiling point of

carbon monoxide of -312°F, with a pressure of at least 200 p.s.i., preferably greater than 450 p.s.i., most preferably between 1,200 to 2,000 p.s.i.g. See col. 3 lines 25 -30; col. 4 lines 29-31; col. 5 lines 25-28; and col. 5 lines 42-45, for example. As such, Smith does not disclose a selective carbon monoxide adsorbent that is active to adsorb carbon monoxide at substantially ambient temperature and pressure conditions and to desorb carbon monoxide at normal shift reactor operating temperature and pressure conditions which are above the ambient temperature and pressure conditions. Further, Smith specifically teaches away from selection of such an adsorbent that adsorbs at mere ambient temperatures, preferring instead adsorbents that adsorb at very low temperatures (approaching -312°F). Col. 5 lines 45-48. As such, Smith does not suggest to one of skill in the art that such adsorbents could be combined with any modern fuel cell system to promote energy efficiency and ameliorate conditions associated with start-up by performing adsorption at ambient temperatures.

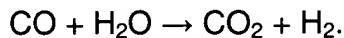
HUFTON ET AL. (“SORPTION ENHANCED REACTION PROCESS FOR HYDROGEN PRODUCTION”)

Hufton relates to an improved fuel cell system that incorporates a sorption enhanced reaction process (SERP) into a conventional fuel cell system. Hufton does not disclose a shift reactor having a reaction region including a water gas shift catalyst and a carbon monoxide adsorbent, nor is there any suggestion or motivation to include a carbon monoxide adsorbent in a reaction region of the shift reactor.

Further, Hufton fails to teach a carbon monoxide adsorbent within the water gas shift reactor that is adapted to adsorb carbon monoxide at substantially ambient temperature and pressure conditions, and to desorb carbon monoxide at normal

operating conditions for the shift reactor, which are above the ambient temperature and pressure conditions.

Rather, Hufton teaches away from including a carbon monoxide adsorbent in a shift reactor because the goal of Hufton is to drive the reaction towards completion by removing a product from the water gas shift reaction:



"Th[is] concept is based on Le Chatelier's principle that (a) the conversion of reactants to products and (b) the rate of forward reaction in an equilibrium controlled reaction can be increased by selectively removing some of the reaction products from the reaction zone." See Hufton at page 249 lines 15 – 19, for example. The entire Hufton reference pertains to improved hydrogen production by driving the reaction to completion by removal of carbon dioxide product. Hence, it would contravene the Hufton reference to remove one of the reactants to drive the reaction back towards producing water and carbon monoxide, rather than towards the product hydrogen. Hufton does not disclose an adsorbent adapted to adsorb carbon monoxide disposed in a reaction region of a shift reactor, and further Hufton teaches away from any combination that would drive the reaction towards the reactant formation and render it inoperable.

KRISHNAMURTHY (USPN 5,096,470)

An object of Krishnamurthy is to maximize the production of carbon monoxide. To this end, Krishnamurthy discloses that it is desirable to avoid incorporating any shift conversion reactors into the separation system. See col. 1 lines 39-42. Krishnamurthy

which does not relate to a fuel cell system, seeks to maximize the concentration of carbon monoxide in the effluent, and thus teaches away from incorporating any shift conversion reactor. As such, Krishnamurthy does not teach, disclose, or suggest combination with any of references related to fuel cells seeking to minimize carbon monoxide formation, particularly those references that disclose incorporating water gas shift reactors, preferential oxidation reactors, or pressure swing adsorbers.

KEEFER ET AL. (WO 00/016425)

Keefer shows a fuel cell system that employs a traditional fuel reformer, with a water gas shift reactor, and a pressure swing adsorber. However, Keefer has no suggestion of incorporating a carbon monoxide adsorbent into a reaction region of a shift reactor. Keefer provides no motivation or suggestion to provide a system that addresses issues associated with start-up conditions, where the fuel cell system is at ambient pressure and temperature conditions prior to reaching normal operating temperatures for the various reactors in the system. Thus, there is no disclosure, suggestion, or motivation to provide a system comprising a shift reactor having a reaction region with both a water gas shift catalyst and a carbon monoxide adsorbent. Further, there is no disclosure, suggestion, or motivation to provide an adsorbent that is active to adsorb carbon monoxide at substantially ambient temperature and pressure conditions and to desorb carbon monoxide at normal shift reactor operating temperature and pressure conditions which are above ambient temperature and pressure conditions, such as that recited in Claims 48 and 49. As such, Keefer does not render the presently

claimed invention obvious by itself, or in combination with any of the other references cited.

Rejections

Claims 7, 29 and 46 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Bellows et al. (U.S. Pat. No.5,604,047, hereinafter, "Bellows"). This rejection is respectfully traversed. Claim 46 was cancelled. Bellows does not disclose, nor does it teach or suggest the limitations of newly added Claim 49, or the claims that depend upon this, namely Claims 7 and 29, which each include a shift reactor having a reaction region including a water gas shift catalyst and a carbon monoxide adsorbent, as described above. As such, Applicants respectfully request that the rejection be withdrawn.

Claim 14 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Bellows et al. (U.S. Pat. No.5,604,047) in view of Hufton et al. ("Sorption Enhanced Reaction Process for Hydrogen Production", AIChE), hereinafter the "Hufton" reference. This rejection is respectfully traversed.

As described above, Bellows does not disclose, nor does it provide any suggestion or motivation to provide a shift reactor having a reaction region including a water gas shift catalyst and a carbon monoxide adsorbent, as recited by Claim 49 and hence by dependent Claim 14. Likewise, Hufton does not disclose a shift reactor having a reaction region including a water gas shift catalyst and a carbon monoxide adsorbent, nor is there any suggestion or motivation to include a carbon monoxide adsorbent in a reaction region of the shift reactor. Further, as addressed above, Hufton teaches away from incorporating a carbon monoxide adsorbent into a shift reactor, and

as such can not be properly combined with Bellows to render the claimed subject matter obvious. As such, Applicants respectfully request withdrawal of the rejection.

Claim 15 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Bellows et al. (U.S. Pat. No. 5,604,047) in view of Smith et al. (U.S. Pat. No. 3,699,218) or Meyer (U.S. Pat. No. 3,011,589). This rejection is respectfully traversed. While Claim 15 has been cancelled, Claims 48 and 49 incorporate similar limitations for the carbon monoxide adsorbent in the shift reactor, namely that the adsorbent is active to adsorb carbon monoxide at substantially ambient temperature and pressure conditions and to desorb carbon monoxide at normal operating temperature and pressure conditions of the shift reactor, where the normal operating temperatures are above the ambient temperature and pressure conditions. For the reasons cited above, Bellows does not disclose, teach or suggest the subject matter recited in Claim 48 or 49. Further, as addressed above, neither Smith nor Meyer disclose a carbon monoxide adsorbent that is active to adsorb carbon monoxide at substantially ambient temperature and pressure conditions and to desorb carbon monoxide at normal operating temperature and pressure conditions of the shift reactor. Rather, both Smith and Meyer teach an adsorbent that adsorbs various components, including carbon monoxide at extreme conditions that are very energy intensive (very high pressures and very low temperatures), which would be unsuitable for the present modern fuel cell application.

Applicants submit that the recitation of an adsorbent having active ranges for adsorbing carbon monoxide, such as those recited in Claims 48 and 49, relates to a physical property of the material. In the course of the interview referenced above, the Examiner suggested that such recitations may not be given any patentable weight in as

much as it is merely functional. In response to this suggestion, Applicants note that a claim limitation which is functional recites a physical property of the invention and is entirely permissible. In this regard, functional claim language that defines something by what it does, rather than by what it is, is not improper. Further, such claim language is to be evaluated and considered just like any other limitation of the claim. See for example, *In re Swinehart*, 169 USPQ 226, 228-230 (CCPA 1971), *In re Barr*, 170 USPQ 330, 336 (CCPA 1971), and MPEP 2173.05(g)

Thus, neither Smith nor Meyer disclose a carbon monoxide adsorbent that is active to adsorb carbon monoxide at substantially ambient temperature and pressure conditions and to desorb carbon monoxide at normal operating temperature and pressure conditions of the shift reactor. Further, Smith and Meyers both teach away from the use of such a material. The presently claimed invention of Claims 48 and 49 are not rendered obvious by Bellows in light of either Smith or Meyer, and as such, Applicants request the rejections be withdrawn.

Claims 2-3, 8, 14-15 and 46-47 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hufton et al. ("Sorption Enhanced Reaction Process for Hydrogen Production", AIChE) in view of Meyer (U.S. Pat. No. 3,011,589). This rejection is respectfully traversed. Claims 15 and 46 are cancelled and Claim 49 has been added. As previously addressed, Hufton does not disclose, teach, or suggest the shift reactor having a carbon monoxide adsorbent. Further, Hufton teaches away from incorporating such an adsorbent into a shift reactor. Also, for the reasons stated above, Meyer does not disclose a suitable adsorbent system for the present fuel cell application. Thus, Hufton teaches away from combination with any reference incorporating a carbon

monoxide adsorbent, and in combination with Meyer does not render new Claim 49, or the claims that depend therefrom, Claims 2-3, 8, 14 and 47 obvious. Accordingly, Applicants respectfully request that the rejection be withdrawn.

Claims 4-7, 16-18, 20-23, 25-26 and 29-30 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hufton et al. ("Sorption Enhanced Reaction Process for Hydrogen Production", AIChE) in view of Meyer (U.S. Pat. No. 3,011,589) and further in view of Keefer et al. (WO 00/16425). This rejection is respectfully traversed. Claim 20 has been cancelled.

As described above, Hufton teaches away from combination with any adsorbent that is active to adsorb carbon monoxide in a shift reactor. Further, the adsorbents disclosed in Meyer are not suitable for use in the present applications, due to such extreme conditions and energy requirements for adsorption. As addressed previously, Keefer also fails to disclose, teach, or suggest a shift reactor having a carbon monoxide adsorbent and a water gas shift catalyst. There is no motivation or suggestion to provide such a combination, and as such, the invention of independent Claims 48 and 49, as well as dependent claims 4-7, 16-18, 21-23, 25-26, and 29-30, are not rendered obvious by Hufton in view of Meyer and Keefer. Applicants respectfully request that the rejections be withdrawn.

Claims 9-11 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hufton et al. ("Sorption Enhanced Reaction Process for Hydrogen Production", AIChE) in view of Meyer (U.S. Pat. No. 3,011,589) and further in view of Krishnamurthy (U.S. Pat. No. 5,096,470). This rejection is respectfully traversed.

As described above, Hufton teaches away from combination with any carbon monoxide adsorbent. The adsorbents disclosed in Meyer are inapplicable to the present subject matter to which the claims are directed. For the reasons previously addressed above, Krishnamurthy teaches away from the combination of a carbon monoxide adsorbent with a system that incorporates a water gas shift reactor to minimize carbon monoxide formation, because it explicitly discloses omitting a shift conversion reaction to achieve a stated goal of maximizing carbon monoxide production. As such, Hufton is not combinable with either Meyer or Krishnamurthy to render the present invention obvious. Applicants request the withdrawal of the rejections of Claims 9-11.

Claims 27-28 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Hufton et al. ("Sorption Enhanced Reaction Process for Hydrogen Production", AIChE) in view of Meyer (U.S. Pat. No. 3,011,589), in view of Keefer et al. (WO 00/16425) and further in view of Krishnamurthy (U.S. Pat. No. 5,096,470). This rejection is respectfully traversed.

As described immediately above, Hufton is not combinable with either Meyer or Krishnamurthy. Further, for the reasons stated above, Keefer has no suggestion or motivation to provide a carbon monoxide adsorbent in a shift reactor, and is not combinable with Krishnamurthy. As the cited references can not be combined, the subject matter of Claims 27 – 28 is not rendered obvious, and Applicants request that the claims be allowed.

Claims 2-8, 14-18, 20-23, 25-26, 29-30 and 46-47 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Keefer et al. (WO 00/16425) in view of

Meyer (U.S. Pat. No. 3,011,589). This rejection is respectfully traversed. Claims 15, 20, and 46 have been cancelled, Claims 48 and 49 have been added.

As described above, Keefer does not disclose, suggest, or motivate one of skill in the art to provide a shift reactor comprising a carbon monoxide adsorbent and a water gas shift catalyst, particularly where the adsorbent is active to adsorb carbon monoxide at ambient pressure and temperature conditions. The adsorbents disclosed in Meyer are inapplicable to the present subject matter to which the claims are directed. Thus, as described previously, there is no suggestion or motivation to combine Keefer with Meyer, and the subject matter of Claims 2-8, 14, 16-18, 21-23, 25-26, 29-30, and 47-49 are not rendered obvious.

Claims 9-11 and 27-28 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Keefer et al. (WO 00/16425) in view of Meyer (U.S. Pat. No. 3,011,589) and further in view of Krishnamurthy (U.S. Pat. No. 5,096,470). This rejection is respectfully traversed.

As described above, Keefer does not disclose, suggest, or motivate one of skill in the art to provide a shift reactor comprising a carbon monoxide adsorbent and a water gas shift catalyst. The adsorbents disclosed in Meyer are inapplicable to the present subject matter to which the claims are directed. For the reasons previously addressed above, Krishnamurthy teaches away from the combination of a carbon monoxide adsorbent with a system that incorporates any reactor that minimizes carbon monoxide formation, because it explicitly discloses omitting a shift conversion reaction to achieve a stated goal of maximizing carbon monoxide production. Thus, as described previously, there is no suggestion or motivation to combine Keefer with Meyer, and

Krishnamurthy teaches away from any such combination. Thus, the subject matter of Claims 9-11 and 27-28 are not rendered obvious. Applicants respectfully request that the rejections be withdrawn in light of the arguments present above.

DOUBLE PATENTING

Claims 2-11, 14-18, 20-23, 25-30 and 46-57 [*sic* 47] stand rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1-34 of U.S. Patent No. 6,692,545 in view of Meyer (U.S. Pat. No. 3,011,589) and further in view of Krishnamurthy (U.S. Pat. No. 5,096,470). Applicants respectfully traverse this rejection. Claims 15, 20, and 46 have been cancelled and Claims 48 and 49 entered.

Applicants note that obviousness-type double patenting rejection pertains to situation where the claimed subject matter is merely an obvious variant of the subject matter claimed in another patent. See MPEP 804(II)(B)(1) and *Eli Lilly & Co. v Barr Labs., Inc.* 58 USPQ.2d 1865 (Fed. Cir. 2001). Initially, this analysis requires a comparison of the claims in the issued patent with the instant claims, not a comparison of the disclosure in the issued patent with the instant claims. See MPEP 804(III) and *In re Bowers*, 149 USPQ 570 (CCPA 1966). It should be noted that the assignee of the present application is a joint owner of the Gittleman patent 6,692,545 (hereinafter, the '545 patent) and the present application also shares a common inventor with the '545 patent. The '545 patent was filed on the same day as the present application, and as such, the '545 patent is not prior art, and the double patenting analysis only requires a one-way test for obviousness.

In the present application, independent Claim 48 is directed to a shift reactor having a water gas shift catalyst and a carbon monoxide adsorbent that is active to adsorb carbon monoxide at substantially ambient temperature and pressure conditions and to desorb carbon monoxide at normal shift reactor operating temperature and pressure conditions which are above said ambient temperature and pressure conditions and does not recite a PSA (pressure swing adsorber). Claim 49 is similarly directed to a shift reactor and further recites a PSA downstream of the shift reactor. The claims of U.S. Patent No. 6,692,545 are *inter alia* directed to a PSA having an adsorbent for adsorbing carbon dioxide which drives the water gas shift reaction to remove CO. The limitations significantly differ from one another, particularly in that the 545' patent claims recite a "carbon dioxide adsorbent" versus the claims of the present invention which recite a "carbon monoxide adsorbent". Additionally, the patent claims are related to a wheel apparatus (e.g., a rotating pressure swing adsorber), rather than reciting the shift reactor of the present claims. The claims of the present invention are patentably distinct from the '545 patent claims, and accordingly the concern for unduly extending a patent term which might warrant a nonstatutory double patenting rejection do not exist. As such, Applicants respectfully request the Examiner to reconsider and withdraw the double patenting rejection and allow Claims 2-11, 14-18, 21-23, 25-30 and 47-49.

CONCLUSION

It is believed that all of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider and withdraw all presently outstanding rejections. It is

believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance. Thus, prompt and favorable consideration of this amendment is respectfully requested. If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (248) 641-1600.

Respectfully submitted,

Dated: December 21, 2004

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